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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,184	12/31/2001	Wilhelm Barthlott	P67142US0	2828
136	7590	08/02/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,184

Applicant(s)

BARTHLOTT ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

Amendment filed on June 4, 2004 has been entered. Claims 1-10 have been cancelled.

New 11-20 claims have been added. Claims 11-20 are pending in the application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Rejection of claims 9, 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to cancellation of the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-15, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dettre et al (US 3,354,022) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on December 4, 2003 since new claims 11-15, 17-19 correspond to original claims 1-5, 7-8 respectively, and claim 9 corresponds to a surface prepared by a method of original claim 3.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dettre et al (US 3,354,022) in view of Groszek et al (US 4,183,757) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on December 4, 2003 since new claim 16 corresponds to original claim 6.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dettre et al (US 3,354,022) in view of Fisher et al (US 4,808,323).

Dettre et al are applied here for the same reasons as set forth in Paragraph No. 4 of the Office Action mailed on December 4, 2003. Dettre et al teach that the waxes having a softening temperature greater than 40°C include natural waxes and synthetic waxes such as paraffin waxes (See column 5, lines 56-62).

Dettre et al fail to teach that waxy polyols and waxy ketones such as palmitone may also be used as a hydrophobic material.

Fisher et al teach that waxy polyols or waxy ketones such as palmitone are functionally equivalent to natural waxes and synthetic waxes such as paraffin waxes (See column 4, lines 43-62) for their use as hydrophobic lubricating material (See column 4, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used waxy polyols or waxy ketones such as palmitone instead of natural waxes

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and synthetic waxes such as paraffin waxes in Dettre et al since Fisher et al teach that waxy polyols or waxy ketones such as palmitone are functionally equivalent to natural waxes and synthetic waxes such as paraffin waxes for their use as hydrophobic lubricating material, and the selection of any of these known material as a hydrophobic material in Dettre et al would be within the level of ordinary skill in the art.

Response to Arguments

8. Applicants' arguments filed June 4, 2004 have been fully considered but they are not persuasive.

Applicants state that, assuming, *arguendo*, that the presently recited "self-organization" might occur in one or more embodiments of the Dettre invention, which applicants do not concede, the limitation is not inherently disclosed in the reference because it is not an inevitable result of the Dettre invention. Dettre expressly teaches the need for "embossing dies" in order to effect the surface protrusions "high portions". Dettre, Example 1 (col. 9, line 40-col. 10, line 26) uses "an embossing die" to produce an "embossed surface gthat) consists of an array of cylindrical projections oriented at right angles to the original wax surface" (Dettre col. 9, lines 50 and 57-59). Examples 2-4 and 6 also use the die-embossing method of Dettre Example 1 in order to produce the desired surface protrusions

The Examiner respectfully disagrees with this argument. In contrast to Applicants' statement, in the last Office Action, the Examiner referred not to Example 1-4 and 6 (which describe the use of "an embossing die"), but to embodiments of examples 7 and 8 where "self-organization" occurs as an inevitable result because, in these examples a coating is applied to a

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glass slide (not to an embossed surface), i.e. Dettre et al do not teach the need for die-embossing in these embodiments.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

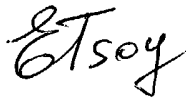
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'ETsoy', is positioned above the typed name.

Elena Tsoy
Primary Examiner
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July 29, 2004